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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,055	05/06/2004	John Blake Slemmer	BE1-0049US	6635
49584	7590	12/02/2005		EXAMINER
LEE & HAYES, PLLC			IWUCHUKWU, EMEKA DERRICK	
421 W. RIVERSIDE AVE.				
SUITE 500			ART UNIT	PAPER NUMBER
SPOKANE, WA 99201			2645	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/840,055	SLEMMER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Emeka D. Iwuchukwu	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 September 2005.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5/6/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on 05/06/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1,2,3,5,20** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2004/0120273 A1 to Border et al. (*hereinafter Border*).

Border teaches the method and system for delivering a stored message to a satellite radio receiver, the method and system comprising: means for receiving a request to retrieve the message (paragraph 53) via a wireless communication device such as a wireless telephone or PDA (paragraph 20); means for receiving the message (paragraph 52); means for encoding the message for satellite transmission (paragraph 66); and transmitting the message for delivery to the satellite radio receiver (paragraphs 20,21).

4. Claims 1,4,6,8,9,15&20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,272,339 to Wiedeman.

**With respect to claims 1,4,6,15&20,** Wiedeman teaches the method and system for delivering a stored message to a satellite radio receiver, the method and system comprising: means for receiving a request to retrieve the message (Col 10 Lines 21-22) via a wireless pager, wherein receiving the request includes receiving identification information associated with a subscriber (Col 4 Lines 36-40; Col 10 Lines 8-12); receiving the message (Col 10 Lines 22-23); encoding the message for satellite transmission (Col 7 Lines 43-45); and transmitting the message for delivery to the satellite radio receiver (Col 5 Lines 60-62; Col 4 Lines 58-61) including uplinking the message to a satellite (Col 7 Lines 29-32).

**With respect to claims 8,9,16,** Wiedeman teaches the method of claim 1, wherein the receiving the message includes retrieving a text message from a message server (Col 10 Lines 21-23).

5. **Claims 1,8,9,10,15&20** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication 2003/0158656 A1 to David.

David teaches the method and means for delivering a stored message to a satellite radio receiver, the method and system comprising: means for receiving a request to retrieve (paragraph 30) an electronic mail message from a message server (paragraph 36); receiving the message (paragraph 38); encoding the message for satellite transmission (paragraph 39); and transmitting the message for delivery to the satellite radio receiver by uplinking the message to a satellite (paragraph 39).

6. **Claims 1,8,9,12,13** are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication 2003/0028890 A1 to Swart et al. (*hereinafter Swart*).

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Swart teaches the method for delivering a stored message to a satellite radio receiver, the method comprising: receiving a request to retrieve (paragraph 60) a text message or voice message (paragraphs 56,92,112) from a message server; receiving the message (paragraph 60); encoding the message for satellite transmission including converting the message to a voice message (paragraphs 56,107,112); and transmitting the message for delivery to a satellite radio receiver (paragraphs 60,111,112).

7. **Claim 17** is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication 2001/0037210 to Hirayama.

Hirayama teaches a computer program stored on a computer readable medium (paragraph 13), the computer program comprising instructions to: retrieve a message stored for a subscriber (paragraph 13); and encode the message for satellite transmission (paragraph 91).

#### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 6&7** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2004/0120273 A1 to Border et al. (*hereinafter Border*) in view of U.S. Patent Publication 2005/0236470 to Hirayma.

Border teaches the method of claim 1. Border fails to expressly disclose receiving identification information such as a password associated with a subscriber with the request.

In the same field of endeavor, Hirayma teaches a similar method wherein receiving the request includes receiving a password associated with the subscriber (paragraph 55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a password associated with the subscriber for security as taught by Hirayma (paragraph 55).

**Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2003/0158656 A1 to David in view of U.S. Patent Publication 2002/0103728 to Naghshineh et al. (*hereinafter Naghshineh*).

David teaches the method of claim 9. David fails to expressly disclose retrieving the text message includes retrieving an electronic fax message.

In the same field of endeavor, Naghshineh teaches a similar method of retrieving an electronic fax message (paragraphs 26,39).

It would have been obvious to modify the method of David to include retrieving fax messages also for versatility.

**Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2003/0006910 to Dame.

Wiedeman teaches the method of claim 1. Wiedeman fails to expressly disclose encoding the message for satellite transmission includes digitizing the message.

In the same field of endeavor, Dame teaches similar method including digitizing the message (paragraph 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to encode the message for satellite transmission by digitizing for increased security during transmission.

**Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2003/0028890 A1 to Swart et al. (*hereinafter Swart*).

Wiedeman teaches the method of claim 1, further comprising receiving the message at the satellite radio receiver (Col 11 Lines 11-13); decoding the message (Col 11 Lines 11-13). Wiedeman fails to expressly disclose presenting the message in audio form.

In the same field of endeavor, Swart teaches converting the message to an audio message and presenting the message in audio form (paragraph 56,107,112).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to present the message in audio form for compatibility as taught by Swart (paragraph 112).

**Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,272,339 to Wiedeman in view of U.S. Patent Publication 2001/0037210 to Hirayama.

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Wiedeman teaches retrieving a message stored for a subscriber (Col 10 Lines 21-23); and encoding the message for satellite transmission (Col 7 Lines 43-48). Wiedeman fails to expressly disclose the above method stored as a program on a computer readable medium.

In the same field of endeavor, Hirayama teaches a similar method stored as a computer program on a computer readable medium (paragraph 13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to store the method as a computer program on a computer readable medium so that it can be transported and implemented on a remote location.

**Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2001/0037210 to Hirayama in view of U.S. Patent Publication 2003/0028890 A1 to Swart et al. (*hereinafter Swart*).

Hirayama teaches the method of claim 17. Hirayama fails to expressly disclose converting the message to an audio message.

In the same field of endeavor, Swart teaches converting the message to an audio message (paragraphs 56,107,112).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to convert the message to an audio message for compatibility as taught by Swart (paragraph 107).

**Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication 2001/0037210 to Hirayama in view of U.S. Patent Publication 2003/0006910 A1 to Dame.

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Hirayama teaches the computer program of claim 17. Hirayama fails to expressly disclose digitizing the message.

In the same field of endeavor, Dame teaches a similar program including digitizing the message (paragraph 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to digitize the message for increased security during transmission.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9AM - 5.30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE  
PATENT EXAMINER**

EDI

*Ovidio Escalante*